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7590	10/19/2004		EXAMINER	
			COE, SUSAN D	
			ART UNIT	PAPER NUMBER
			1654	
DATE MAILED: 10/19/2004				

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below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/674,752

**Applicant(s)**

FUKUDA, HARUI

**Examiner**

Susan D. Coe

**Art Unit**

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 10/169,874.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/30/03; 11/28/03</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

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### **DETAILED ACTION**

1. The preliminary amendment filed September 20, 2003 has been received and entered.
2. Claims 18-20 have been cancelled.
3. Claims 1-17 are currently pending.

### ***Specification***

4. The amendment filed September 30, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the amendment to the specification deletes all mention of the shoots of pine leaves. By deleting this specific type of shoot, applicant has altered the initial disclosure to remove a previously preferred embodiment. This broadens the initial disclosure because now all of applicant's examples are not necessarily drawn to the same composition that was disclosed in the parent application. Thus, by deleting a preferred embodiment, applicant has altered the original disclosure in a manner that introduces new matter to the application.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claim 15 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 15 is indefinite due to the phrase “spontaneous fermentation.” It is unclear how a “spontaneous fermentation” differs from a normal fermentation.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-6, 16, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 61289865.

Applicant's claims are drawn to a composition comprising fermented pine shoots.

JP '865 teaches a fermented pine sprout composition. Sprout is synonymous with shoot (see [dictionary.reference.com/search?q=sprout](http://dictionary.reference.com/search?q=sprout)). The pine sprouts are mixed with sugar and water and then fermented.

The reference does not specifically teach that the composition has the same effects on the body as those claimed by applicant; however, since the composition taught by the reference is the same as the claimed composition, the reference composition would inherently have to have the same effects if applicant's invention functions as claimed.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 61289865.

As discussed above, JP '865 teaches a fermented pine shoot composition. The composition is made by adding sugar and then water to pine shoots followed by anaerobic fermentation for 3 months. The reference method differs from claims 7, 11, and 13 because the reference does not specify that the sugar is dissolved in the water before the sugar is mixed with the pine shoots. However, this small difference in mixing steps would be a change that would be obvious for a person of ordinary skill in the art to employ. The end solution is the same, pine shoots mixed with water and sugar. The sugar would dissolve in the water producing a solution of dissolved sugar. Thus, unless applicant can demonstrate a difference between the mixing order of the reference and the mixing order claimed, the claimed invention is not considered patentably distinct from the reference.

The reference also does not specifically teach fermenting for over three months or at the temperatures claimed by applicant. However, the parameters of a fermentation are variables that are well known in the art to be routinely optimized. It would be routine experimentation for a person of ordinary skill in the art to determine the optimal amount of time for the fermentation and the optimal temperature in order to best achieve the fermented composition taught by the

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reference. Thus, absent some demonstration of unexpected results from the claimed parameters, this optimization of ingredient amount would have been obvious at the time of applicant's invention.

The reference does not specifically teach that the fermented composition produced functions as remedy for allergic diseases. However, the reference is considered to teach the same production method claimed by applicant. Thus, since the method taught by the reference is the same as the claimed method, the method taught by the reference would have the same characteristics as claimed and would function equivalently.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP '865 as applied to claims 7-14 above, and further in view of JP 07-0159538.

JP '865 is considered to teach the claimed fermentation method as discussed above. However, JP '865 does not teach placing the fermentation vessel in direct sunlight. JP '538 teaches that it is known in the art to ferment pine products under direct sunlight. Thus, since this technique is known in the art to be appropriate for fermentation, a person of ordinary skill in the art would be motivated to use this known technique in the fermentation taught by JP '865.

9. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (571) 272-0963. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30 and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell, can be reached on (571) 272-0974. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

A handwritten signature in cursive script, reading "Susan D. Coe".

Susan D. Coe, Examiner

October 1, 2004